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09/827,233	04/05/2001	Cary Lee Bates	RSW920010047US1	7213

7590 02/27/2007  
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EXAMINER

ENGLAND, DAVID E

ART UNIT PAPER NUMBER

2143

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 09/827,233	Applicant(s) BATES ET AL.	
	Examiner David E. England	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 06 November 2006.
- 2a)  This action is FINAL.                          2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-20 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-20 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.
  - Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  - Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All   b)  Some \* c)  None of:
    - 1.  Certified copies of the priority documents have been received.
    - 2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - 3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5)  Notice of Informal Patent Application
- 6)  Other: \_\_\_\_\_.

DL

**DETAILED ACTION**

1. Claims 1 – 20 are presented for examination

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 is vague and indefinite because it is unclear what is the association and/or relationship between the web page and the email.

4. Claims 1 – 3, 8 – 11 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 – 3, 8 – 11 and 16 are vague and indefinite because it is unclear what is a preferred viewing order.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 – 3, 5, 7, 9 – 11, 13, 15 and 17 – 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Carter (6859213).

7. As broadly drafted and as best the Examiner can ascertain from the language of the claims, claims 1-3, 5, 7, 9-11, 13, 15, and 17-20 do not define any structure/step that differs from Carter.

8. Carter teaches claims:

9. 1. A method for providing email that enables a recipient of the email to navigate readily through a set of web pages associated with the email, comprising the acts of:

10. composing an email to be sent from an originator to a recipient; (abstract; "A method and apparatus for selecting attachments. When a sender indicates in an e-mail application or applet that an attachment is to be associated with an e-mail message, an attachment chooser window is presented. The attachment chooser window provides a browser-based graphical user interface (GUI) which allows a sender to browse data resources, such as HTML documents and associated links. An attachment mechanism is provided by which a sender can choose a currently displayed data resource for attachment in an e-mail message. In one embodiment, the attachment mechanism allows a user to select whether the attachment is retrieved and attached to an e-mail message as a resource locator (such as a URL) of the chosen data resource, or whether source data of the data resource is retrieved and attached to the e-mail message as one or more source files.")

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11. in response to input of the originator, generating a web page navigation ("a browser-based graphical user interface (GUI) which allows a sender to browse data resources") that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient;

(col.3, lines 17-41)

12. associating the navigation with the email; and (307)

13. sending the email and the navigation to the recipient. (col.3, lines 17-41; col.4, line 45-col. 5, line 26)

14. 2. A method for guiding a recipient of an email readily through a set of web pages associated with the email (Figs. 5A, 5B), comprising the acts of:

15. receiving an email; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

16. receiving a web page navigation associated with the email; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

17. passing the web page navigation to a web browser; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

18. displaying by the web browser (400) a preferred viewing order in which web pages identified by the web page navigation are to be viewed; and (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

19. wherein the preferred viewing order is included in the navigation. ("Headers above the message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214, and

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"Priority" 215. Messages in the list can be sorted by subject, by sender or receiver, by ascending or descending date, by urgency, or by any combination thereof.")

20. 3. A method for providing email that guides a recipient readily through a set of associated web pages (Figs. 5A, 5B), comprising the acts of:

21. composing an email to be sent from an originator to a recipient; in response to input of the originator, generating a web page navigation (400) that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

22. sending the email and the web page navigation to the recipient; passing the web page navigation to a web browser used by the recipient; and displaying by the web browser an indication of the preferred viewing order. ("Headers above the message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214, and "Priority" 215. Messages in the list can be sorted by subject, by sender or receiver, by ascending or descending date, by urgency, or by any combination thereof.")

23. 5. The method of claim 3, wherein the indication of the preferred viewing order is provided by icons. (216)

24. 7. The method of claim 3, wherein the indication of the preferred viewing order is provided by forward and backward browser controls. (403,404)

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25. 9. Programmable media containing programmable software for providing email that guides a recipient readily through a set of associated web pages, the programmable software comprising the acts of:

26. composing an email to be sent from an originator to a recipient; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

27. in response to input of the originator, generating a web page navigation (400) that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient;

28. associating the navigation with the email; and sending the email and the navigation to the recipient. ("Headers above the message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214, and "Priority" 215. Messages in the list can be sorted by subject, by sender or receiver, by ascending or descending date, by urgency, or by any combination thereof.")

29. 10. Programmable media containing programmable software for providing email that guides a recipient readily through a set of associated web pages (Figs. 5A, 5B), the programmable software comprising the acts of:

30. receiving an email; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

31. receiving a web page navigation associated with the email; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

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32. passing the web page navigation to a web browser; and displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

33. wherein the preferred viewing order is included in the Web page navigation. ("Headers above the message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214, and "Priority" 215. Messages in the list can be sorted by subject, by sender or receiver, by ascending or descending date, by urgency, or by any combination thereof.")

34. 11. Programmable media containing programmable software for providing email that guides a recipient readily through a set of associated web pages (Figs. 5A, 5B), the programmable software comprising the acts of:

35. composing an email to be sent from an originator to a recipient; in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

36. sending the email and the web page navigation to the recipient; (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

37. passing the web page navigation to a web browser used by the recipient; and (passing 500 to 501)

38. displaying by the web browser an indication of the preferred viewing order. ("Headers above the message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214,



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and "Priority" 215. Messages in the list can be sorted by subject, by sender or receiver, by ascending or descending date, by urgency, or by any combination thereof.")

39. 13. The method of claim 11, wherein the indication of the preferred viewing order is provided by icons. (216)

40. 15. The method of claim 11, wherein the indication of the preferred viewing order is provided by forward and backward browser controls. (403,404)

41. 17. The method of claim 1, wherein the preferred viewing order is specified by the originator and the email sent to the recipient contains the plurality of uniform resource locators and the preferred viewing order. ("Headers above the message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214, and "Priority" 215. Messages in the list can be sorted by subject, by sender or receiver, by ascending or descending date, by urgency, or by any combination thereof.")

42. 18. The method of claim 1, wherein an email program of the originator and a web browser of the originator together generate the web page navigation. (abstract; col.3, lines 17-41; col.4, line 45 - col. 5, line 26)

43. 19. The method of claim 1, wherein the web page navigation is incorporated into the email sent to the recipient. (abstract; col.3, lines 17-41; col.4, line 45-col. 5, line 26)

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44. 20. The method of claim 1, further comprising: receiving the email and the web page navigation with an email program of the recipient; passing the web page navigation to a web browser of the recipient; and displaying an indication of the preferred order with the web browser of the recipient. ("Headers above the message list indicate such information as "Subject" 212, "To/From" 213, "Date" 214, and "Priority" 215. Messages in the list can be sorted by subject, by sender or receiver, by ascending or descending date, by urgency, or by any combination thereof.")

*Claim Rejections - 35 USC § 103*

45. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

46. Claims 4, 6, 8, 12, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carter in view of Bates et al. (6963901) (hereinafter Bates).

47. Cater discloses all of the claimed limitations except for a showing of a preferred viewing order having various link colors and fonts.

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48. Bates is applied for showing a browser program 240 (e.g. font, color, background, screen sizing, display attributes and other user configurable settings; at col.4, lines 25-35, col. 4, line 57-co15 line 15) having preference file 244 for navigating web links.

49. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use Carter's method and apparatus to select attachments to navigate readily through a set of web pages associated with an email and to select any desirable view/display order, as taught by Bates, by incorporating a preferred colored links and/or fonts in order to provide a visible mark to show the degree of importance and order ranking.

#### *Response to Arguments*

50. Applicant's arguments filed 11/06/2006 have been fully considered but they are not persuasive.

51. **In the Remarks**, Applicant argues in substance that there is no requirement under 35 U.S.C. § 112, second paragraph, that each recited feature of a claim have an association or relationship to another recited feature. Nor has the Examiner cited any basis in law for such an assertion. Even if the Examiner were correct, the Examiner would have to ignore the clear language of claim 2 to make such an assertion because claim 2 in fact recites receiving a web page navigation associated with the email. Thus, the Examiner's assertion is without legal basis and contradicted by the very claim language asserted to be indefinite. Furthermore, Applicants submit that contrary to the Examiner's assertions, Applicants are not required under section 112,

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2nd paragraph, to limit the invention to any particular cooperative relationship between the recited steps. To the extent that the Examiner relies upon MPEP 2172.01, the Examiner has misread MPEP 2172.01, which indicates that when it is indicated "by applicant" in the specification that certain features are essential to the invention, such features must be recited in the claims. The Examiner has identified no features which were indicated "by Applicant" to be critical and which are not recited in the claims.

52. As to the first Remark, Applicant is misunderstanding the reason for the rejection and is citing section of the MPEP that do not apply. What is meant by rejection which states "that the claim is indefinite because it is unclear what is the association and/or relationship between the web page and the email is, "How is the web page navigation associated with the email?" What makes the web page connected to the email? In the independent claim 1, it is understood the relationship between the web page navigation and the email because it is stated that the URLs are composed in the email by the input of the originator. Claim 2 is void of such language or any language that states the web page navigation and URLs are attached in the email. Rejection still stands and await clarification or cancellation.

53. **In the Remarks**, Applicant argues in substance that the Examiner asserts that claims 1-3, 8-11 and 16 are indefinite because "it is unclear what is a preferred viewing order." Applicants respectfully disagree with this assertion of indefiniteness. Applicants note that the specification clearly and specifically explains what is meant by the language asserted to be indefinite. Applicants note, for example, that the language "preferred viewing order" relates to a viewing order that is defined by the originator and which informs the recipient that the URLs provided in

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the email should be viewed in a particular order designated by the originator. The term "preferred" is not being used in the way typically found to be objectionable under current USPTO rules, such as when it is used to designate alternative features and/or both broad and narrow definitions of the same recited feature in a claim, e.g., a device comprising a fastener, preferably a screw.

54. As to the second Remark, Applicant has not pointed to any part of the specification to support their meaning of the phrase "preferred viewing order". Furthermore, the Applicant state above in their remarks, *"Applicants note, for example, that the language "preferred viewing order" relates to a viewing order that is defined by the originator and which informs the recipient that the URLs provided in the email **"should" be viewed in a particular order** designated by the originator."* This would leave one to interpret that the receiver does not have to abide by the "preferred order" and therefore could be interpreted and just an order, random or planned. With this understanding and description that the Applicant has given, this would mean that the "preferred order" has no patentable wait because if the receiver does not have to abide by the order then the "preferred order" is arbitrary. Applicant is asked to give a confirm or state otherwise why this interpretation is incorrect while pointing out specific sections of the specification to support their response.

55. **In the Remarks**, Applicant argues in substance that Carter does not disclose, or even suggest, that the sent email includes a viewing order of the HTML documents, much less, a preferred viewing order.

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56. As to the final Remark, Applicant is asked to draw their attention to Figures 4 – 7 and columns 7 et seq., along with sections previously cited, in view of the Applicant's claim language. Applicant does not claim specifically what "a preferred viewing order" could be and therefore can be interpreted as any order the "originator" deems fit, i.e., the order is not program determined and can be any order selected by the "originator". Now if the Applicant will view column 7, line 36 – column 8, line 47, one can obviously see that Carter teaches the prior art of a "viewing order" and "a selected or preferred viewing order". Carter teaches a "GoTo" field 402 which is used to provide on the "chooser interface" which contains the URL of the current web page and permits the sender to specify a particular URL which is then displayed in the display region 400. The sender can then enter another URL in the GoTo field and request that URL. This action then activates the "previous page button" and allows the sender to use this button similarly as a previous button on a web browser and when selected allows a user to go to the previously view page by accessing the history of the display region 400, e.g., col. 8, lines 26 – 47 & col. 11, line 17 – col. 13, line 34. Furthermore, as taught in column 12, the program can attach a URL to the email that is in the GoTo field. This would also make very apparent to one of ordinary skill in the art that once a sender has chosen an URL to attach to the email, the sender can then select a link or type in manually in the GoTo field another URL to attach to the email. This would now start the "document stack", col. 12, line 12 – col. 13, line 34, that is accessed from a receiver or sender to view the different attached URLs that are attached using the "next button" or "previous button". Since it is in the senders complete control as to what they would like save as an attachment in the email, then that would mean they can determine a "preferred order" if they so

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deem for the recipient, which is saved from the history of URLs that are placed in the GoTo field.

57. Applicant's arguments in regards to Bates also fall under the assumption that Carter does not teach the claimed invention and therefore the response above can be applied here with the same rationale.

58. Applicant is invited to contact the Examiner to clear up any ambiguity or discuss claim amendments to further prosecution.

### *Conclusion*

59. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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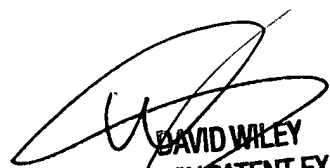
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David E. England  
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Art Unit 2143

DE *DE*

  
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